

## **REMARKS**

The Examiner has made the October 22, 2004 restriction requirement final. The Applicants have elected Group I (claims 1-24). Group II (Claim 25) is therefore withdrawn without prejudice.

The Applicant will address each of the bases of rejection in Sections I-IV, which follow.

### **I. Objections to Claims 8 and 23-24**

Claims 8 and 23-24 have been amended in the interest of clear and expeditious examination. Specifically, Claim 8 has been amended to contain a proper Markush group. Claims 23 and 24 have been amended to more succinctly claim the subject matter and qualify that the percentages therein refer to weight percentages. No new matter has been added as a result of the amendments to Claims 8 and 23-24. Additionally, no claim scope has been surrendered as a result of these amendments. The Applicants believe that the amendments of Claims 8 and 23-24 are sufficient to overcome the Examiners objections to those claims and place the claims in condition for allowance.

### **II. Other Amendments to Claims**

Claims 1-7 and 9-22 have also been amended in the interest of clear and expeditious examination to more succinctly claim the subject matter. For example, claim 12 has been amended to contain a proper Markush group. No new matter has been added, and no claim scope has been intentionally surrendered, as a result of these amendments.

### **III. 35 U.S.C. §112**

Claims 11-24 have been rejected as allegedly being indefinite under 35 U.S.C. §112, second paragraph. The Office Action states that Claim 11 is unclear as to whether the polymer binding agent must bind with the wet concrete. Claims 12-24 either depend from Claim 11 directly or depend from another Claim that depends from Claim 11. The Applicants have therefore removed the phrase “capable of integrally binding” from Claim 11 and amended the claim to positively recite a binding step. The Applicants believe that this amendment fully addresses the rejection by the Examiner under 35 U.S.C. §112, second paragraph.

The Applicants note that amendments have also been made to the dependency of Claims 20 and 22 so that they now depend from Claim 14 rather than Claim 11. The Applicants believe that Claims 11-24 are now in condition for allowance.

**IV. 35 U.S.C. §103(a)**

**A. *Patent Publication 2003/0197310 by Bailey et al.***

Patent Publication 2003/0197310 by Bailey et al. (“Bailey publication”) is the publication of U.S. Patent Application No. 10/127,861 (the “Bailey application”), which was filed on April 22, 2002. The Applicants note that the pigment used in the “preferred embodiment” of the Bailey publication is “SPR 9000 series color available from Hamburger Color Company.” Hamburger Color Company is the original Assignee of the current application, as recorded in the USPTO on October 1, 2003 at Reel No. 014555 and Frame No. 0106. The application was later assigned to Rockwood Pigments as recorded on November 19, 2004 at Reel No. 015394 and Frame No. 0262. Though the Bailey publication does not disclose it, the SPR 9000 series color products do contain a polymer binding agent. Because the present inventors invented the pigments in question prior to the April 22, 2002, filing date of the Bailey application, however, the Bailey publication is not prior art to the present application.

Each of the claims of the present application as currently amended requires a first spray color dispersion comprising a pigment water dispersion and a polymer binding agent. As shown in the Declaration under 37 C.F.R. §1.131 executed by the inventors, attached to this Response, the SPR 9000 series color products referred to in the Bailey publication are a commercial embodiment of the spray color dispersions claimed in the present application. Furthermore, as shown in the attached Declaration, Hamburger Color Company developed the SPR 9000 series color products prior to the April 22, 2002, filing date of the Bailey application. Because prior invention of the claimed subject matter has been established in accordance with 37 C.F.R. §1.131, the Bailey publication is not prior art to the present application and the rejection based upon the Bailey publication has been overcome.

*B. Patent Publication 2003/0197310 by Bailey et al. in view of U.S. Patent No. 4,946,505 by Jungk*

The Office Action has relied upon U.S. Patent No. 4,946,505 to Jungk (“Jungk”) in combination with the Bailey publication. The Applicants note that a combination of the Bailey publication and any other reference to support a rejection of any of the present claims is inappropriate in light of the discussion above establishing that the Bailey publication is not prior art to the present application. Additionally, the Applicants respectfully disagree with the representation that one of skill in the art would combine Bailey and Jungk because the teachings of Jungk (to homogeneously dispersed pigment granules in concrete) are inconsistent with the teachings of the Bailey application (to spray a liquid color dispersion onto concrete). There is therefore no motivation to combine the two references or expect that such a combination would lead to successful results.

*C. Patent Publication 2003/0197310 by Bailey et al. in view of U.S. Patent No. 4,946,505 by Jungk and in further view of Kirk-Othmer*

Claims 7-9 and 19-21 have been rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Patent Publication 2003/0197310 by Bailey et al. (“Bailey”) in view of U.S. Patent No. 4,946,505 by Jungk and in further view of Kirk-Othmer. The Applicants note that a combination of the Bailey publication and any other reference to support a rejection of any of the present claims is inappropriate in light of the discussion above establishing that the Bailey publication is not prior art to the present application. The Applicants also note that, for the reasons stated above, it would not be obvious to combine the Bailey publication and Jungk because the teachings of Jungk are inconsistent with the teachings of the Bailey publication. It is therefore inappropriate to combine Bailey, Jungk and Kirk-Othmer in forming a rejection to claims 7-9 and 19-21. Instead, these claims should be allowed.

*C. Patent Publication 2003/0197310 by Bailey et al. in view of U.S. Patent No. 4,946,505 by Jungk and in further view of U.S. Patent No. 5,846,315 by Johansen, Jr. et al.*

Claim 13 is currently rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Patent Publication 2003/0197310 by Bailey et al. (“Bailey”) in view of U.S. Patent No. 4,946,505 by Jungk and in further view of U.S. Patent No. 5,846,315 by Johansen, Jr. et al.

("Johansen"). The Applicants note that a combination of the Bailey publication and any other reference to support a rejection of any of the present claims is inappropriate in light of the discussion above establishing that the Bailey publication is not prior art to the present application. The Applicants also note that, for the reasons stated above, it would not be obvious to combine the Bailey publication and Jungk because the teachings of Jungk are inconsistent with the teachings of the Bailey publication. It is therefore inappropriate to combine Bailey, Jungk and Johansen in forming a rejection to claim 13. Claim 13 should therefore be allowed.

### **Conclusion**

In view of the arguments set forth above, The Applicants believe that the claims as currently amended contain allowable subject matter. The Applicants therefore request that the Examiner allow all of the pending claims as currently amended.

Though no fee is believed to be due in connection with this response, the Commissioner is hereby authorized to charge any additional fees that are presently required, or credit any overpayment, to Deposit Account No. 13-0017.

Respectfully submitted,



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